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10/810,146	03/25/2004	Gregg J. Palmer	112300-2103	8364
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K&L Gates LLP P.O. Box 1135 CHICAGO, IL 60690				
EXAMINER				
SAGER, MARK ALAN				
ART UNIT		PAPER NUMBER		
3714				
NOTIFICATION DATE		DELIVERY MODE		
11/24/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

# Office Action Summary

**Application No.**

10/810,146

**Applicant(s)**

PALMER ET AL.

**Examiner**

M. Sager

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/22)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 9/16/09

***Claim Interpretation***

1. Per MPEP 2111.04, claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are (A) “adapted to” or “adapted for” clauses, (B) “wherein” clauses, and (C) “whereby” clauses. The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “whereby” clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” *Id.* However, the court noted (quoting *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”” *Id.* The wherein clauses herein fail to state condition material to its patentability.
2. Also, while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In *re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board’s finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinchart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-*

Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Also, it is reiterated that a claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference that taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.). The functions herein are environment of use or optional recitations that fail to distinguish over manner of use of structure of references.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned

with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-47 of U.S. Patent No. 6506118. Applicant is reminded that they are entitled to one patent for one invention. Citations herein are with respect to '118 claims where features/function is claimed and its specification for showing enablement/interpretation of features/functions claimed therein. Although the conflicting claims are not identical, they are not patentably distinct from each other because method and gaming device claimed herein is the method and gaming device claimed by '118 for awarding a prize to player based on position moves regarding all features and functions where '118 further claims means controlled by processor for enabling player to determine the initial offer provided to the player from the plurality of offers that would be interpreted by an artisan at time prior to invention as software/firmware including a memory device storing instructions that when executed by process enables functions of '118 providing offer to player including providing prize/award/bonus to player. Alternatively, where '118 lacks claiming a memory device which stores instructions which when executed enable processor to perform those functions and '118 lacks providing the player any award associated with the determined position if player accepts the award. Regarding memory device, it is conventional for a plurality of software instructions to be stored in a memory device to enable functions to be performed by processor or that a processor inherently includes RAM and/or ROM that stores instructions to enable functions. As evidence under MPEP 2131.01 see Greenwood 4991848, fig 2; Heidel 552488 fig 3-5; Safari

5769716 fig 4, or; Baerlocher 5788573 2:20-36, 3:13-44; each reference previously of record).

In this case, the processor of '118 inherently uses a memory device storing instructions that when executed by processor enables '118 claimed functions to be performed or, in the alternative, where '118 claimed gaming device is hardwired rather than programmed (the Office disagrees with this interpretation of '118 claims, but includes alternative interpretation) it would have been obvious to an artisan at a time prior to the invention to apply the technique of a memory device storing a plurality of instructions which when executed by the processor causes the gaming device to enable '118 functions claimed to be performed or, in the alternative, it would have been obvious to substitute one method (hardwired) for the other method (programmed in a memory device that stores instructions that when executed by processor enables its functions) to achieve the predictable result of enabling function claimed by '118 to be performed for ease of re-programming since reprogramming gaming device having a memory device is more easily accomplished than either can be reprogrammed or replaced over rewiring a hardwired gaming device, as known in programming and gaming art. '118 teach structure including memory device storing program instructions (5:8-24).

Regarding providing the player any award function, paying bonus/prize to player is deemed obvious so as to payout accepted award to player as claimed by '118. However, the Office maintains the means for providing of claim 9 or display device displays offer of claim 1, 28 and 30 anticipate claimed providing function as would be interpreted by an artisan prior to invention since scope of providing does not require payout, transfer, dispensing, allocating, allotting or disbursing of award, but such forms of providing are obvious for a wagering gaming device of '118. In addition, '118 provide awards to player (15:16-38).

Furthermore, the 'ranking' of '118 claims is position (9:5-7) on a path (12:25-32, 47-65 also see claims 17-23, 42-45) where positive and negative values are associated with upward and downward sloping path such that '118 claims a display device as display device herein, '118 claims offer acceptor (also noteworthy is claimed selections of claims 11-16, 38-41) as input device herein, '118 claims processor as processor herein performing claimed functions including make an initial offer and enable player to obtain a ranking [i.e. position as noted above regarding interpretation therein], wherein the rankings [i.e. position] is divided into two ranges as determining an initial position each of the positions is in one of position ranges, each of the position ranges is associated with a plurality of position moves, the position moves associated with a first position range include positive values and position range associated with second position range include positive and negative values and a plurality of awards are associated with a plurality of positions. Also, '118 claims enabling a player to accept the offer made to player (also see claims 2-12, 23-27, 31-41 and 46 regarding offers and selections) as enabling a player to accept or reject any award associated with a determined position herein.

Finally, regarding data network and internet, '118 lacks claiming use of data network including internet; however, use of a data network including internet would have been obvious to an artisan at a time prior to invention as suggested by Baerlocher (2:20-36, 3:13-49) to increase accessibility, accounting, maintenance, management or updating. In addition, '118 teach use of internet (5:46-58).

5. Claims 1-59 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6793579 and over claims 1-22 of U.S. Patent No. 6796905 and over claims 1-53 of U.S. Patent No. 7192349. Although the

conflicting claims are not identical, they are not patentably distinct from each other because method and gaming device claimed herein is the method and gaming device claimed by '579, '905 and '349 for awarding a prize to player based on position moves regarding all features and functions since '579, '905 and 349 likewise claim display device, input device and processor where memory device and providing step remain obvious if not implicitly claimed and the analysis above regarding '118 equally applies regarding '579, '905 and '349 which are continuations thereof thereby having same teachings.

***Claim Rejections - 35 USC § 102***

6. Claims 1-59 rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher (6506118). Analysis above regarding '118 is incorporated herein.

The applied reference has a common assignee and/or inventor(s) with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

***Terminal Disclaimer***

7. The terminal disclaimer filed on 9/24/09 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6719632 has been reviewed and is accepted. The terminal disclaimer has been recorded.



***Response to Arguments***

8. Applicant's arguments, see paper, filed 9/24/09, with respect to the rejection(s) of claim(s) 8-1022-24, 32-36 and 55-59 under 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Baerlocher. Further, although Baerlocher '349 is a CIP, the claimed gaming device is deemed obvious form of present claims in that present claims are species thereof where present claims could have been filed in '349 where analysis is similar to '118 regarding interpretation of claims therein as applied to features herein. *In re Berg*.
9. Applicant's arguments, see paper, filed 9/24/09, with respect to non-statutory subject matter have been fully considered and are persuasive. The rejection of claims 25-29, 32-34, 37-39, 42-45, 48-52 and 55-57 has been withdrawn.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Sager/  
Primary Examiner, Art Unit 3714